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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,534	01/27/2004	Shigeki Iwanami	03-040	9452
23400	7590	04/18/2007	EXAMINER	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			FRANTZ, JESSICA L	
ART UNIT		PAPER NUMBER		3746
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/18/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/764,534	IWANAMI ET AL.
	Examiner	Art Unit
	Jessica L. Frantz	3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 1/27/2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.  
 4a) Of the above claim(s) 3,5 and 8-26 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,4,6 and 7 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 8/25/2004, 1/27/2004.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election without traverse of Species 1 drawn to Figure 2 in the reply filed on 3/1/2007 is acknowledged. Applicant states that claims 1, 2, 6-7 and 23 read on Species 1. However, upon further consideration, it is noted that the limitations of claim 23 and intervening claim 21 were not discussed in reference to Species 1 and do not read on Species 1. Since they are directed to a non-elected species, they will not be examined on the merits. Also, Applicant considers claims 1, 6-7 and 23 generic. However, since claim 1 is only drawn to a subcombination required by every Species, it is not a generic claim. Nor are those that depend from it. Therefore, no claim is generic. "In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species. In general, a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim." MPEP 806.04(d) [R-3]. The restriction/election requirement is made **FINAL**.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication, in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 6-7 rejected under 35 U.S.C. 102(b) as being anticipated by Sakai et al. 6,234,769. Sakai teaches the invention substantially as claimed including a fluid machine (as shown in figure 4), which is operable in a pump mode for pressurizing fluid and discharging the pressurized fluid from the fluid machine and is also operable in a motor mode for converting fluid pressure of fluid into kinetic energy and thereafter outputting the kinetic energy as mechanical energy, the fluid machine comprising: a housing 501; at least one movable member 512 that is received in the housing, wherein each movable member defines a working chamber  $V_c$  having a variable volume in the housing; and a valve mechanism 552, 554 that opens and closes at least one communication passage 553, 551 arranged in the housing, wherein each communication passage communicates between the corresponding working chamber and a high pressure chamber 515, wherein: the valve mechanism enables flow of fluid from each working chamber to the high pressure chamber and blocks backflow of fluid from the high pressure chamber to each working chamber at time of operation of the fluid machine in the pump mode; and the valve mechanism opens at least one of the at least one communication passage at time of operation of the fluid machine in the motor mode (see Sakai column 7, line 24- column 8, line 39). Sakai further teaches the at least one communication passage includes: a first communication passage 553, which conducts fluid at the time of operation of the fluid machine in the pump mode;

and a second communication passage 551, which conducts fluid at the time of operation of the fluid machine in the motor mode; and the valve mechanism includes: a check valve 554, which opens and closes the first communication passage; and an electric switching valve 552, which opens and closes the second communication passage. Sakai further teaches a dynamo-electric machine 530 that rotates in response to displacement of the movable member is located in the housing 501 (please see Sakai figure 4).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al. 6,234769 in view of "Manufacturing Engineer's Reference Book" edited by Koshal (hereafter noted as Koshal). Sakai teaches the invention substantially as claimed but fails to explicitly teach the switching valve is a pilot type which includes a valve body that is displaced to open and close the second communication passage. Koshal teaches that pilot valves are well known and may be operated mechanically or electrically as is currently most common. He further teaches they include a valve body (internal switching element) that opens or closes a passage (see Koshal 12.6.2) and they are advantageous because the electric pilot valves need only be pulsed since the pilot line in the valve supplies

air to move the spool and it is usually unnecessary to maintain an energized condition (see Koshal 11.7.4). Regarding the limitation "to open and close the second communication passage by controlling a back pressure applied to the valve body" it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim. Therefore, it would have been obvious to use the pilot valve as taught by Koshal for the purpose of opening and closing the communication passage because electric pilot valves need only be pulsed since the pilot line in the valve supplies air to move the spool and it is usually unnecessary to maintain an energized condition (see Koshal 12.6.2 and Koshal 11.7.4).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Frantz whose telephone number is 571-272-5822. The examiner can normally be reached on Monday through Friday 8:30a.m.-5:00p.m. E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JF

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